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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,488	09/29/2003	Frederic Pialot	033818-009	8468

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT PAPER NUMBER

1733

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/671,488

Applicant(s)

PIALOT, FREDERIC

Examiner

Geoffrey L. Knable

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9-29-2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, drawn to a process depositing uncured rubber to form a contrasting motif on the outside of a tire, classified in class 156, subclass 116.
  - II. Claims 7-11, drawn to a tire mold, classified in class 425, subclass 28.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the mold as claimed can be used to practice another and materially different process such as placing a volume of rubber equal to the volume of the insert cavity to form the motif.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Alan Kopecki on November 18, 2005 a provisional election was made with traverse to prosecute the invention of group I, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 1 as well as claim 2, line 2, reference is made to "uncured" rubber whereas in claim 1, line 7, reference is made to "non-vulcanized" rubber - as it seems that these are intended to be referring to the same material, it is suggested that consistent terminology be adopted to avoid confusion created by use of different terms for the apparently same material.

An analogous ambiguity is created by the reference to "uncured" rubber in claim 6, line 1 and "non-vulcanized" rubber in claim 6, line 7.

Also, in claim 6, line 7, no antecedent has been established for "said first non-vulcanized rubber mix".

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makinson et al. (US 5,653,840) taken in view of at least one of [Bohm et al. (US 5,296,077) and DE 3046572 to Continental].

Makinson et al. discloses a process of depositing colored rubber on a tire sidewall in which the colored rubber is deposited in a cavity in the mold sidewall of a form of the desired sidewall motif, the volume of rubber placed in this cavity being less

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than the volume of the cavity - note especially figs. 11-13, the volume of the cavity being defined as being between the projections 130 and 132, it being clear that the interface between the sidewall and strip is above/outward of the bottom of the grooves formed by the projections and thus the volume of material would be less as claimed. Building the tire blank and molding against the inserted sidewall rubber is also considered to be implicit or certainly obvious from the reference disclosure. This reference is therefore considered to suggest a method as claimed except that the cavity is within the mold itself rather than using a removable insert.

Bohm et al. is also directed to applying colored rubber to the sidewall of a tire where the rubber is preapplied in a shaped recess in the mold and in particular indicates that this recess can be either directly in the mold or can be in the form of a fixture that includes the recess and fits in a housing within the mold - note esp. col. 11, lines 39-66. Similarly, DE '572 is directed to applying colored sidewall material from a mold recess and likewise indicates that the recess can suitably either be in the mold itself or in an insert (8 in fig. 6) that fits within a housing in the mold (compare figs. 5 and 6). To form the desired shaped recess of Makinson et al. alternatively in a removable insert that fits within a housing in the mold would therefore have been seen to be an obvious alternative to the ordinary artisan skilled in this art for only the expected results. Such would further be expected to advantageously provide a more readily changed motif configuration.

As to claim 2, the particular relative volumes would have been readily and routinely optimized depending upon the desired location of the boundary between

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layers, it further being considered that the guidance provided by the Makinson et al. drawings (and especially the location of the boundary relative to the depth of the cavity) would have suggested that filling less than 80% of the volume would have been seen to be generally within the teachings of this reference. As to claim 3, note for example the recesses beneath the overhanging projections 130 and 132. As to claim 5, note grooves 40/42.

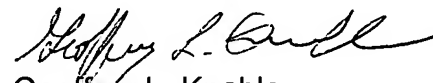
8. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makinson et al. (US 5,653,840) taken in view of at least one of [Bohm et al. (US 5,296,077) and DE 3046572 to Continental] as applied above, and further in view of Williams et al. (US 2,985,216).

As to claims 4 and 6, to include plural different color layers for a sidewall appliqué would have been obvious in view of Williams et al. which suggests using plural layers of different colors to aid in visibility of the appliqué as well as enable unique identification - note esp. col. 2, lines 20-25 and col. 3, lines 19-30.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Geoffrey L. Knable  
Primary Examiner  
Art Unit 1733

G. Knable  
November 23, 2005